



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/595,787

05/11/2006

Andree Burgstaler

72216

6702

23872 7590 09/14/2009
MCGLEW & TUTTLE, PC
P.O. BOX 9227
SCARBOROUGH STATION
SCARBOROUGH, NY 10510-9227

EXAMINER

LUONG, VINH

ART UNIT

PAPER NUMBER

3656

MAIL DATE

DELIVERY MODE

09/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,787	Applicant(s) BURGSTALER ET AL.	
	Examiner Vinh T. Luong	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3656

1. The preliminary amendment and the substitute specification filed on May 11, 2006 have been entered.

2. The drawings are objected to because of the reasons, e.g., listed below:

(a) The drawings are not in compliance with 37 CFR 1.84. Please see Form PTO-948 attached; and

(b) Each part of the invention, such as, “a securing member” in ¶ 23 of the specification or the securing means in claim 14 should be designated by a reference character. Please see MPEP § 608.01(o).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3656

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed feature(s), such as, the securing means in claim 14 (Spec. ¶ 23) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

4. The disclosure is objected to because of the following informalities: each part of the invention, such as, “a securing member” in ¶ 23 of the specification or the securing means in claim 14 should be designated by a reference character. Please see MPEP § 608.01(o). Appropriate correction is required.

5. Claims 16-20 are objected to because of the following informalities: the claims have typographical or grammatical error. For example, the recitation “said a bearing bolt” in line 4 of claim 16 should have been changed to “said bearing bolt.” Appropriate correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the term that appears at least twice, such as, “a pedal lever” in lines 1 and 4 of claim 1 refers to the same or different things. Please see double inclusion in MPEP § 2173.05(o).

Claim 13 recites the limitation "said predetermined breaking point." There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3656

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-15, as best understood, and claims 16-20 are rejected under 35 U.S.C. 103(a) as being obvious over Wolpert (US 6354171 cited in the specification) in view of Burgstaler et al. (DE 10064770 cited by Applicant).

Claim 1

Wolpert teaches a device for mounting a pedal lever 14, 16 of a motor vehicle, the device comprising:

a bearing block 12 (FIG. 1);

a pedal lever 14, 16 mounted in a pivotingly movable manner about a pivot axis 18 that is arranged at said bearing block 12 and is designed as a bearing bolt 12;

an abutment 66, 70 located at a spaced location from the bearing block 12; and

a tear-off member 46 comprising a two-armed lever 46 (FIGS. 2 and 3) arranged between said bearing block 12 and said abutment 66, 70, said tear-off member 46 for shearing off the

Art Unit: 3656

bearing bolt 12 of the pedal lever 14, 16 as a consequence of the action of an external force caused by a crash due to a relative motion between said tear-off member 46 and said bearing block 12 while a shearing force is applied, said tear-off member 46 being supported at said bearing block 12 at said pivot axis 18 of said pedal lever 14, 16 of the bearing block 12.

In summary, Wolpert teaches the invention as claimed except that Wolpert's tear-off member and the lever has the same pivot axis. Spec. ¶ 4.

Burgstaler teaches the rearrangement of the tear-off member 5 being supported at the bearing block 3 at a spaced location from the pivot axis 2 of the pedal lever 1 of the bearing block 2 in order to, *inter alia*, improve the shearing action.

It would have been obvious to one having ordinary skill in the art to rearrange Wolpert's tear-off member such that it is supported at the bearing block at a spaced location from the pivot axis of the pedal lever of the bearing block in order to, *inter alia*, improve the shearing action as taught or suggested by Burgstaler. The rearrangement of Wolpert's tear-off member as taught or suggested by Burgstaler would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739. See also legal precedent regarding rearrangement of parts in MPEP § 2144.04.

Claim 2

The support of Burgstaler's tear-off member 5 comprises a pivotingly movable support.

Claim 3

Art Unit: 3656

Wolpert's pedal lever comprises a pedal 14, 16.

Claim 4

Burgstaler's tear-off member 5 is in contact with an arc-shaped contour of the bearing block 3 in a pivotingly movable manner. The unnumbered arc-shaped contour of the bearing block 3 is engaged with the arc-shaped contour 8 of the tear-off member (FIGS. 1 and 2).

Claim 5

Burgstaler's contour on the bearing block (FIG. 2) has an arc-shaped design with a convex arch.

Claim 6

Burgstaler's tear-off member 5 has a concave arch 8 that is complementary to the contour of the bearing block 5 (FIG. 2).

Claim 7

Wolpert's tear-off member 46 is designed as a profiled part with two lateral legs 48 and 50 (FIG. 2). Similarly, Burgstaler's tear-off member 5 is designed as a profiled part with two lateral legs (at 5 in FIG. 1).

Claim 8

Wolpert's tear-off member 46 is capable of being designed as a deep-drawn part. On the other hand, the determination of patentability is based on the product itself, not by its method of production. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006), and MPEP § 2113.

Claim 9

Art Unit: 3656

The lateral legs 48 and 50 of Wolpert's profiled part are in contact with the pedal lever 14, 16 in a positive-locking manner in the immediate vicinity of the pivot axis 18 of the pedal lever 14, 16. Similarly, the lateral legs of Burgstaler's profiled part are in contact with the pedal lever 1 in a positive-locking manner in the immediate vicinity of the pivot axis 12 of the pedal lever 1.

Claim 10

Wolpert's tear-off member 46 is designed as a profiled part is in contact with the abutment 66, 70 in a positive-locking manner.

Claim 11

Wolpert's tear-off member 46 is capable of being in contact with the abutment 66, 70 such that the abutment 66, 70 dips into a recess (unnumbered in FIG. 3) between the lateral legs 48 and 50 of the tear-off member 46 and is surrounded by the legs 48 and 50 in a positive-locking manner. Similarly, Burgstaler's tear-off member 5 is capable of being in contact with the abutment 7 such that the abutment 7 dips into a recess 4 between the lateral legs 5 of the tear-off member 5 and is surrounded by the legs 5 in a positive-locking manner (FIG. 2).

Claim 12

Wolpert's abutment 66, 70 is arranged on a stationary vehicle cross rail 64. Similarly, Burgstaler's abutment 7 is arranged on a stationary vehicle cross rail/crossbeam.

Claim 13

Burgstaler's bearing bolt 2 has at least one said predetermined breaking point 9 (FIG. 3).

Claim 14

Burgstaler's tear-off member 5 has a securing means for mounting on the bearing block.

Art Unit: 3656

Claim 15

Wolpert's device or Burgstaler's device for mounting the pedal lever of a motor vehicle is capable of being designed as a preassembled module with the tear-off member. *In re Thorpe; SmithKline Beecham Corp. v. Apotex Corp.*; and MPEP § 2113 *supra*.

Claims 16-20

See claims 1, 2, and 4-6.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 1, as best understood, and claim 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Burgstaler et al. (DE 10064770).

Claim 1

Burgstaler teaches a device for mounting a pedal lever 1 of a motor vehicle, the device comprising:

a bearing block 3 (FIG. 1);

a pedal lever 1 mounted in a pivotingly movable manner about a pivot axis 2 that is arranged at said bearing block 3 and is designed as a bearing bolt 2;

an abutment 7 located at a spaced location from the bearing block 3; and

a tear-off member 5 comprising a two-armed lever (see two arms 14 and 15 in FIG. 1) arranged between said bearing block 3 and said abutment 7, said tear-off member 5 for shearing off the bearing bolt 2 of the pedal lever 1 as a consequence of the action of an external force

Art Unit: 3656

caused by a crash due to a relative motion between said tear-off member 5 and said bearing block 3 while a shearing force is applied, said tear-off member 5 being supported at said bearing block 3 at a spaced location from said pivot axis 2 of said pedal lever 1 of the bearing block 3 as seen in FIGS. 1 and 2.

Claim 16

Burgstaler teaches a pedal lever mounting arrangement comprising:

a bearing block 3;

a bearing bolt 2 supported by said bearing block 3 to define a pivot axis;

a pedal lever 1 mounted in a pivotingly movable manner to said bearing bolt 2;

a vehicle abutment part 7 located at a spaced location from said bearing block 2; and

a tear-off member 5 arranged between said bearing block 3 and said abutment 7 for shearing said bearing bolt 2 as a consequence of the action of an external force causing a relative motion between said tear-off member 5 and said bearing block 3, said tear-off member 5 being supported at said bearing block 3 at a spaced location from said pivot axis 2.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Suzuki (lever 12), Didiez et al. (lever 17), Chamaillard (lever 12), and English translation of DE 10064770 A1 shown in US 6923088 B2 and US 2003/0000335 A1.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

Art Unit: 3656

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656